REMARKS / ARGUMENTS

A. GENERALLY

Claims 36-62 are pending in the Application. Claims 1-9 and 19-35 are presently canceled. Claims 10-18 were previously canceled. Claims 36-62 have been added. No new matter has been added.

Applicant appreciates the opportunity for an interview afforded the Applicant on March 22, 2006. Applicant's summary of the interview is provided below.

B. CLAIM REJECTIONS

Claim Rejections Under 35 USC §103(a)

Claims 1-9 and 19-35 have been rejected as being unpatentable under 35 USC §103(a) over over International Publication WO 99/63759 of an application entitled, "Television Delivery System," filed by Cameron et al. (herein, "Cameron") in light of U.S. Patent 6,061,719 issued to Bendinelli, et al. (herein, "Bendinelli").

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP §2143.03, 8th Ed. (Rev. 2, 2004). Further, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP §2143.01, 8th Ed. (Rev. 2, 2004).

It is also well established that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). MPEP §2143.01, 8th Ed. (Rev. 2, 2004). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP §2143.01, 8th Ed. (Rev. 2, 2004).

Claim 1, as examined, recited the following limitations:

1. A method for multi-casting video content to a user computer, the method comprising:

distributing a video content program stream from a content center to a regional data center via an open network;

distributing the video content program stream from the regional data center to a user computer via a distribution network according to a multi-cast protocol;

transmitting non-video data related to the video content program stream to the user computer; and

displaying the non-video data on the user computer contemporaneously with the video content program stream.

The examiner found that Cameron does not teach or disclose the limitations, "transmitting non-video data related to the video content program stream to the user computer," and "displaying the non-video data on the user computer contemporaneously with the video content program stream." The examiner found these limitations are taught by Bendinelli (see, Bendinelli, Col. 3, lines 16-29 and Bendinelli, Col. 3, lines 48-50).

Bendinelli describes using a portion of the vertical blanking interval (BVI) of an NTSC analog television signal reserved for closed captioning data to convey network information identifiers (e.g., URLs) to a decoder connected to a television. The decoder would capture the URL and provide the URL to a retrieval device (e.g., a computer). The user may select the web page for continuous display. Otherwise, the web page would be replaced when a new network information identifier is decoded and sent to the retrieval device. The examiner suggested adding this capability to Cameron.

Applicant submits that combining Cameron with Bendinelli would change the principle of operation of the Cameron. In an office action mailed July 28, 2005, the examiner stated that Cameron taught the transmission of non-video data. According to the examiner, this non-video data included interactive television, web browsing, web-based email, IPG, VOD and pay per view services through the digital TV manager (DTVM). (See Office Action of July 28, 2005, pages 5-6.)

Applicant agrees that Cameron does not teach or disclose the limitations, "transmitting non-video data related to the video content program stream to the user computer," and "displaying the non-video data on the user computer contemporaneously with the video content program stream." However, the only means taught by Bendinelli to accomplish this limitation is

through a limited data field in the VBI set aside for closed caption data. Clearly, there is no motivation to graft this means onto Cameron because the tasks described in the Cameron limitations would quickly overwhelm the limited bandwidth offered by the VBI closed-caption space.

Applicant further submits that it is inappropriate to read Bendinelli as teaching the broader concept of displaying the non-video data on the user computer contemporaneously with the video content program stream. Applicant submits that this reading of Bendinelli is inspired by Applicant's disclosure and constitutes the kind of hindsight that the courts have recognized is not permissible:

> "It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The inventors in both Cameron and Bendinelli were confronted with the problem of providing non-video data to a recipient of video programming. Neither of these inventive entities reached Applicant's solution.

For the foregoing reasons, Applicant submits that the claims of the present application, as examined, are not obvious over the combination of Cameron and Bendinelli.

As suggested by the examiner, Applicant has added new claims that more clearly identify the invention, particularly the display elements illustrated in Figure 3 of the application. New claim 36 recites the following limitations:

> 36. (New) A method for multi-casting video content to a user computer, the method comprising:
>
> distributing a video content program stream from a content center to a regional data center via an open network;
>
> distributing the video content program stream from the regional data center to a user computer via a distribution network according to a multi-cast protocol;
>
> transmitting non-video data comprising a viewer participation activity, wherein the user computer is adapted for converting the video content program stream and the non-video data into an on-screen video display arranged into regions; and
>
> displaying the viewer participation activity in a viewer participation region

contemporaneously with displaying the video content program stream in a video content region.

Claim 36 recites limitations directed to the display of the video content program stream and the non-video data comprising a viewer participation activity within defined regions of an on-screen video display. The added limitations are supported by the Specification of the present application and Figures 3 through 8 of the present application. The cited references do not teach or describe an on-screen video display having a region associated with a video content program screen and a region associated with a viewer participation activity related to the video content program stream.

New claims 59-62 recite limitations directed to the use of markers to control the storage and display of video content. Neither Cameron nor Bendinelli recite the use of markers to buffer and display non-video data. Applicant submits that new claims 59-62 are allowable over the cited prior art.

Applicant appreciates the opportunity afforded by the examiner to discuss other art identified by the examiner during an Interview held on March 22, 2006. Applicant has filed an Information Disclosure Statement to make this art of record. In particular, the examiner referenced U.S. Patent 6,240,555 issued to Shoff et al. (herein, "Shoff"), U.S. Patent 6,415,438 issued to Blackketter et al. (herein, "Blackketter"), and U.S. Patent 6,668,378 issued to Leak et al. (herein, "Leak").

Shoff describes an interactive entertainment system for supplying interactive supplemental content along with continuous video content programs to viewers. The programs are continuous, non-interactive data streams, such as television shows, movies, or other video content. An electronic programming guide (EPG) is stored in the memory and provides information that is descriptive of the video content programs. The EPG also maintains a data field that indicates whether the video content program is interactive. The EPG data field contains a pointer, universal resource locator, or other target specification to the target resource that supports the interactive content. The target resource also contains display layout instructions prescribing how the supplemental content and the video content program are to appear in relation to one another when displayed on the television or monitor. When the data from the target resource is downloaded to the viewer computing unit, the processor is responsive to the layout instructions obtained from the target resource to display the supplemental content concurrently

with the video content program.

Shoff relies on data conveyed by an EPG to obtain supplemental content relating to a program. The display of the supplemental content is determined by layout instructions that are part of the target resource. Thus, Shoff does not teach or disclose an on-screen display having a video content region and a viewer participation region. Additionally, Shoff does not teach or disclose the use of buffering and display markers.

Leak describes an interactive television system in which information from an information resource may be displayed along with television video in a synchronized fashion. When information is to be displayed at a point in the television video, a communication called a "trigger" is broadcast along with the television video. The trigger identifies the information resource and indicates how information from the information resource is to be displayed. Content is classified as either "disconnected content" or as "connected content". That is, disconnected interactive television content is content that, once present on the receiver unit, likely involves no further connection to the Internet. Connected content, on the other hand, is interactive television content that likely does involve an Internet connection. The interactive television system comprises some receivers that cannot establish connections to the Internet and therefore cannot properly process triggers to connected content. The system also involves other receiver units that can establish connections to the Internet and can process triggers to connected content. To avoid receiver failures, a trigger comprises a connected content/disconnected content attribute that identifies the trigger as being either a trigger to disconnected content or a trigger to connected content. Receiver units that cannot process triggers to connected content use the attribute to identify triggers to such connected content and to ignore such triggers. Receiver units in the system that can establish connections to the Internet, on the other hand, can receive and execute both triggers to connected content and triggers to disconnected content.

For receivers that cannot connect to the Internet, a relay station uses the connected content/disconnected content attribute to identify disconnected content triggers, to retrieve the identified disconnected content from the Internet, and to relay that disconnected content to the receiver units.

Another embodiment described in Leak uses two triggers. The first trigger alerts the relay station that disconnected content is to be prefetched from the Internet. The relay station

prefetches the disconnected content identified by the first trigger from the Internet and relays it to the receiver units (for example, via VBI lines 10-20 of an NTSC broadcast television video signal) before the second trigger that actually triggers the enhancement on the receiver unit is received. In this way, the disconnected content is already present on the receiver unit when the second trigger arrives at the receiver unit.

The triggers described by Leak are not the markers recited in claims 59-62. As used in those claims, the buffering marker and display marker are inserted into a video content program stream for reception and execution by the user computer. As a result of the receipt of the markers by the user computer, content is obtained from the video content program stream and is stored on the user computer and served to the display from the user computer. The "triggers" described in Leak are not both received by the user computer. Rather, the relay station "fetches" the content identified by a first trigger and makes it available to a disconnected content receiver in response to a second trigger. The fetched content is not stored on the "user computer" and is not displayed from the memory of the user computer.

Blackketter describes an interactive television system in which a trigger includes a time attribute indicative of a time in the future when the trigger is to be executed. Execution of the trigger causes a receiver to retrieve information from a location identified in the trigger. The trigger may be sent in advance when there is adequate transport bandwidth to transport the trigger to the receiver unit. The receiver unit therefore waits until the indicated future time to execute the trigger. The future time may be determined by clock time or by reference to a frame number within a video program. A receiver unit may also pre-fetch an information resource so that it is available at the future time or future frame when the trigger is to be executed.

The triggers described by Blackketter are not the markers recited in claims 59-62. As used in those claims, the buffering marker and display marker are inserted into a video content program stream for reception and execution by the user computer. As a result of the receipt of the markers by the user computer, content is obtained from the video content program stream and is stored on the user computer and served to the display from the user computer. The content described in Blackketter is not derived from the video program content stream. Rather, the content is "fetched" from a location identified by a first trigger.

C. CONCLUSION

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 36-62. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests an interview with the examiner and the examiner's supervisor prior to any new office action relating to the present Application. Attorney for the Applicant may be reached at the number listed below.

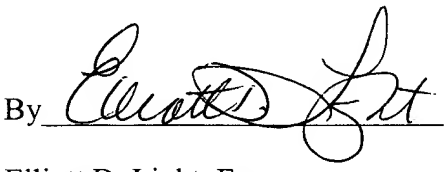
D. SUMMARY OF INTERVIEW

On February 22, 2006, a telephonic interview was conducted in which Elliott D. Light participated for the Applicant and Examiner Michael Hoye participated for the U.S. Patent and Trademark Office. The current office action and cited references were discussed. No agreement was reached as to the claims or the references. The participants agree to schedule a follow-up interview.

A second telephonic interview was conducted On March 22, 2006 in which Elliott D. Light and Jon L. Roberts participated for the Applicant and Examiners Michael Hoye and Scott Beliveau participated for the U.S. Patent and Trademark Office. The participants discussed in general terms the claims as examined, the references cited in an Office Action mailed December 15, 2006 and claims proposed by Applicant. The examiner's suggested that Applicant amend the claims to specifically claim the display element referenced in Figure 3 (among others). Applicant was also referred to the Shoff, Leak and Blackketter references discussed above. No agreement was reached on the claims.

The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully Submitted,

By 

Elliott D. Light, Esq.
Registration No. 51,948
Jon L. Roberts, Esq.
Registration No. 31,293
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191
703-391-2900